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10/705,276	11/10/2003	Toru Ichiki	03676LH	4894
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EXAMINER ZHANG, FAN				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/705,276

**Applicant(s)**

ICHIKI, TORU

**Examiner**

FAN ZHANG

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Jan 23, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendments***

1. Applicant's amendment filed on Jan 23, 2008 is acknowledged. Currently, claims 1-5 and 7-13 are pending. Claim 6 has been canceled, claims 1-5 currently amended, and claims 7-13 newly added.

Applicant's arguments with respect to claims 1-5 and 7-13 are moot in view of new grounds of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al (Pub No. US2002/0015182) and further in view of Tomida (Patent No. US 6,922,255).**

**Regarding claim 1**, Akiyama et al teach:

An image forming apparatus (fig. 1, "Summary of the Invention"), comprising: a communication device for communicating with an external apparatus by a facsimile communication procedure (fig. 1, also [0039-0041] i.e. communication with external telephone 4 via PSTN subscriber line3); a data processor for obtaining image data and

communication control data by decoding facsimile communication data from the external apparatus received by the communication device (fig. 1, i.e. CPU 11 serves this purpose. For details, see also fig. 4); a memory for storing the image data obtained by the data processor, in association with identification data to identify the image data (fig. 1, i.e. image storage section 15 serves this purpose); an image output device for forming and outputting an image based on the image data (fig. 1, i.e. printer 18 serves this purpose).

Akiyama et al continue to teach: an identification electronic mail creating device (fig. 1, mail server 6); a transmission and reception device for transmitting and receiving emails (fig. 4 for mail transmission process and fig. 5 for mail reception process); an electronic mail processor ([0058, 0067], figs. 4 and 5); and a control section (fig. 1, CPU 11).

Akiyama et al do not teach prompting a receiver through email to set one of a plurality of image data processing modes and process the received image data based on the receiver selected mode which can be either terminal transmission mode or printing mode. In the same field of endeavor, Tomida teaches (col 11, lines 1-38; fig. 13) : an identification electronic mail creating device for, when the communication control data has been obtained by the data processor, creating an identification electronic mail for notifying that the facsimile communication data has been received and prompting a receiver of the identification electronic mail to set one of a plurality of image data processing modes for the image data, said identification electronic mail including the identification data of the image data; a transmission and reception device

for transmitting the identification electronic mail to an electronic mail address and for receiving an instruction electronic mail from an external terminal in response to the identification electronic mail, said instruction electronic mail containing the identification data of the image data and an instruction to set one of the plurality of image data processing modes for the image data; an electronic mail processor for extracting the instruction to set one of the plurality of image data processing modes and the identification data of the image data from the received instruction electronic mail; and control section which controls the image forming apparatus to process the image data in accordance with the image data processing mode instructed by the instruction extracted by the electronic mail processor; wherein the plurality of image processing modes include a terminal transmission mode and a printing mode; and wherein when the terminal transmission mode is instructed by the instruction extracted by the electronic mail processor, the control section controls the image forming apparatus to transmit the image data to the external terminal, and when the printing mode is instructed by the instruction extracted by the electronic mail processor, the control section controls the image forming apparatus to output the image data by the image output device.

Having a device for setting different image processing modes on facsimile data by executing commands selected by user through email would help minimize unnecessary data printing and reduce transmission process. Therefore, the combined teaching of Akiyama et al and Tomida as a whole would have been obvious to one of ordinary skilled in the art.

**Regarding claim 2**, the rationale applied to claim 1 has been incorporated herein. Akiyama et al further teach: the image forming apparatus of claim 1, further comprising: a transmission table for storing an electronic mail address in association with a transmitter of the facsimile communication data, wherein the transmitter of the facsimile communication data is identified in the communication control data, wherein the identification electronic mail creating device extracts the electronic mail address to which the identification electronic mail is to be sent from the transmission table based on the transmitter (of the) of the facsimile communication data identified in the communication control data. (See figure 2, paragraphs [0046], and [0050], a recipient-address storage area is reasonable interpretation of "transmission table" as claimed).

**Regarding claim 3**, the rationale applied to claim 1 has been incorporated herein. Akiyama et al further teach: the image forming apparatus of claim 1, further comprising a processing table for storing a transmitter of the facsimile communication data and information with respect to whether the image data corresponding to the communication control data should be sent to the image output device or the memory, wherein the transmitter of the facsimile communication data is identified in the communication control data, wherein the data processor sends the image data to a predetermined receiver by referring to the processing table, based on the (based on the) transmitter (of the) of the facsimile communication data identified in the communication control data. (Akiyama et al teaches in paragraphs [0052] and [0053] a

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communication capability storage section as a reasonable interpretation of "processing table" claimed).

Akiyama et al do not specify exact information stored in the processing table as claimed in the invention. Tomida teaches information with respect to whether the image data corresponding to the communication control data should be sent to the image output device or the memory (col 7, lines 47-52; col 11, lines 9-19).

**Regarding claim 4**, the rationale applied to the rejection of claim 1 has been incorporated herein. Akiyama et al further teach: the image forming apparatus of claim 1, further comprising an input device for specifying a receiver to which the identification electronic mail is to be sent, when the identification electronic mail creating device creates the identification electronic mail ([0044, 0086, and 0089]). Tomida also teaches the input device for specifying destination in (col 4, lines 8-11).

**Claim 7** has been analyzed and rejected w/r to claim 4 and in accordance with the rationale applied to the rejection of claim 1.

**Regarding claim 8**, the rationale applied to the rejection of claim 1 has been incorporated herein. Akiyama et al do not specify if an identification email includes image data. Tomida teaches: the image forming apparatus of claim 1, wherein the identification electronic mail does not include the image data (col 11, lines 12-19. As

prescribed, only mail list and mail titles are displayed with no image data included before user specifies an instruction.)

**Claim 9** has been analyzed and rejected w/r to claim 1.

**4. Claims 5, 12 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al (Pub No. US2002/0015182) and Tomida (Patent No. US 6,922,255) as applied to claims 1 and 9 respectively, and further in view of Matsumoto (Pub No.: US 2002/0186401).**

Regarding claim 5, the rationale applied to the rejection of claim 1 has been incorporated herein. Akiyama et al and Tomida do not teach a deletion device for deleting the output image data although Tomida teaches a deletion device for deleting a stored title for an incoming fax in (col 6, lines 1-10). In the same field of endeavor, Matsumoto further teaches: the image forming apparatus of claim 1, further comprising a deletion device for deleting the output image data ([0117, 0118], claim 5). Using a deletion device to delete unwanted image data store in a memory of a fax machine has been well known and practiced in the art as prescribed by Matsumoto. Therefore, it would have been obvious to an ordinary skilled in the art to combine Akiyama et al and Tomida's teaching with Matsumoto's for deleting any unwanted image data to free up memory space of a fax machine.



**Claim 11** has been analyzed and rejected w/r to claim 5 and in accordance with the rationale applied to the rejection of claim 9.

**Claim 12** has been analyzed and rejected w/r to claim 5.

**5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al (Pub No. US2002/0015182) and Tomida (Patent No. US 6,922,255) as applied to claim 9, and further in view of Wiley et al (Pub No.: US 2003/0084105).**

**Regarding claim 10**, the rationale applied to the rejection of claim 9 has been incorporated herein. Akiyama et al and Tomida do not disclose forwarding the received image data to other destination by fax. In the same field of endeavor, Wiley et al teach: the image forming apparatus of claim 9, wherein the specified destination is one of: (i) an electronic mail address, to which the image data is transmitted by electronic mail, and (ii) a telephone number, to which the image data is transmitted by facsimile ([0049], fig. 4). Transmitting received image data to another destination by either email or fax has been well practiced in the art as prescribed by Wiley et al. Therefore, combining Akiyama et al and Tomida's teaching with Wiley et al's to directly transmit a received image data to another party for convenience would have been obvious to an ordinary skilled in the art.

6. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al (Pub No. US2002/0015182) and Tomida (Patent No. US 6,922,255) as applied to claim 1, and further in view of Okimoto et al (Patent No.: US 6,449,055).**

**Regarding claim 13**, the rationale applied to the rejection of claim 1 has been incorporated herein. Tomida teaches: the image forming apparatus of claim 1, wherein the instruction in the instruction electronic mail to set the printing mode, and when the printing mode is instructed by the instruction extracted by the electronic mail processor, control section controls the image forming apparatus to print the image data by the image output device (col 11, lines 9-29). Neither Akiyama et al nor Tomida prescribe sending an instruction on a number of copies to be printed. In the same field of endeavor, Okimoto et al teach: includes an instruction to print a number of copies of the image data, and prints the instructed number of copies of the image data by the image output device (col 11, lines 32-39). Therefore, the combined teaching of Akiyama et al, Tomida, and Okimoto et al as a whole, and the benefit of convenience by adding an option of setting desired number of copies to be printed through email command would have been obvious to an ordinary skilled in the art.

### ***Conclusion***

7. Applicant's amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fan Zhang whose telephone number is (571) 270-3751. The examiner can normally be reached on Mon-Fri from 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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